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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,044	11/14/2003	Laurence G. Dammann	20435-00145-US1	9023
30678	7590	05/18/2005	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ LLP			SELLERS, ROBERT E	
SUITE 800			ART UNIT	
1990 M STREET NW			PAPER NUMBER	
WASHINGTON, DC 20036-3425			1712	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,044

Applicant(s)

DAMMANN ET AL.

Examiner

Robert Sellers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, 14-28 and 37-44, drawn to a liquid oligomeric composition comprising a cycloaliphatic epoxide and a Michael addition polyacrylate reaction product, classified in class 525, subclass 471.
- II. Claims 12 and 13, drawn to the liquid oligomeric composition further comprising a modifying epoxide, classified in class 525, subclass 524.
- III. Claims 29-31, drawn to the liquid oligomeric composition further comprising an acidifying agent, classified in class 525, subclass 529.
- IV. Claims 32-36, drawn to the liquid oligomeric composition further comprising a monoacrylate, classified in class 525, subclass 531.
- V. Claims 45-49 and 53, drawn to a polymerized product cured from a liquid oligomeric composition comprising a cycloaliphatic epoxide, a cationic photoinitiator and a Michael addition polyacrylate reaction product, classified in class 522, subclass 31.
- VI. Claim 50, drawn to a method of making a liquid oligomeric composition, classified in class 522, subclass 66.
- VII. Claims 51 and 52, drawn to a method of applying a liquid oligomeric composition to a substrate, classified in class 427, subclass 517.

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The inventions are distinct from each other because of the following reasons:

1. Inventions I and (II or III or IV or V) are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive formulation and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.
2. Inventions (II or III or IV) and V are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a molding composition and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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3. The liquid oligomeric compositions of Inventions II, III and IV further comprise additional materials of a modifying epoxide, acidifying agent and monoacrylate, respectively, which materially affect the mechanical and physical properties of the compositions.

4. Inventions VI and (I or II or III or IV or V) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another materially different product or (2) that the product as claimed can be made by another materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another materially different process such as the premixing of the cycloaliphatic epoxide and Michael addition polyacrylate reaction product in the presence of a solvent followed by blending the cationic photoinitiator.

5. Inventions (I or II or III or IV or V) and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as the bonding of two substrates with the liquid oligomeric composition.

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6. The method of making the liquid oligomeric composition of Invention VI involves materially different blending steps from the method of applying the liquid oligomeric composition of Invention VII employing the distinct process step of application to a substrate.

Restriction for examination purposes as indicated is proper because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification.

7. This application contains claims directed to the following patentably distinct species of the claimed invention:

a) The multifunctional acrylate Michael acceptors of claim 2 such as the blend of hexanediol diacrylate and trimethylolpropane triacrylate used in the preparation of Michael addition polyacrylate resin A of Table I on page 15 of the specification (paragraph 67).

b) The β -dicarbonyl Michael donors of claim 2 such as the ethyl acetoacetate employed Michael addition polyacrylate resin A.

c) The Michael addition reaction wherein a single species of base is elected from claim 17.

d) The liquid oligomeric compositions with or without the free-radical generator of claims 37-39, wherein if its presence is elected, a particular species thereof is identified from claim 39.

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e) The liquid oligomeric compositions with or without the cationic photoinitiator incorrectly defined in lines 4-5 of claim 39 and claims 40-42, wherein if its presence is elected, a particular species thereof is identified such as the triarylsulfonium hexafluoroantimonate salt CD-1010 utilized in Examples 1-5 of Table I (page 16, lines 4-5).

Contingent upon the election of Group II, items a), b) and c) hereinabove and the modifying agents wherein a single species is elected from claim 13.

Contingent upon the election of Group III, items a), b) and c) hereinabove and the acidifying agents such as the hydroxyethyl methacrylate phosphate utilized in Examples 1-5 of Table I (page 15, last line to page 16, line 1, Ebecryl 168).

Contingent upon the election of Group IV, items a), b) and c) hereinabove and the monoacrylates wherein a single species is elected from claim 33.

Contingent upon the election of Group V, items a), b) and c) hereinabove and:

i) The cationic photoinitiators such as the triarylsulfonium hexafluoroantimonate salt CD-1010 utilized in Examples 1-5 of Table I (page 16, lines 4-5).

ii) The polymerized products with or without the free-radical generator of claim 46, wherein if its presence is elected, a particular species thereof is identified such as either the actinic light of claim 47 or the peroxide of claim 48.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species within each of the appropriate items a), b), c), d) and e) as well as the further species contingent upon the elected group for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, claims 1-53 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

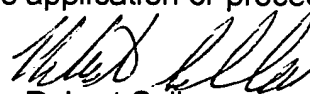
The reply to this requirement to be complete must include an election of the invention and species to be examined even though the requirement be traversed (37 CFR 1.143).

Upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Claim 39, lines 4-5 contains the sentence "The liquid oligomeric composition, according to claim 2, further comprising a cationic photoinitiator." It assumed that the sentence was intended to comprise a separate claim. The sentence should be rewritten as new claim 54 and claims 40-42 dependent upon the subject matter of the sentence should be cancelled and re-introduced as new claims 55-57 dependent upon new claim 54. Group I would then comprise claims 1-11, 14-28, 37-39 and 54-57 if the aforementioned amendment is instituted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Robert Sellers
Primary Examiner
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